

ESTTA Tracking number: **ESTTA289060**

Filing date: **06/10/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Platinum Community Bank, FSB		
Entity	federally chartered savings bank	Citizenship	United States
Address	2915 W. Kirchoff Rd. Rolling Meadows, IL 60008 UNITED STATES		

Attorney information	Jeffrey B. Sladkus, Esq. Jeffrey B. Sladkus, LLC 1827 Powers Ferry Road Building 6, Suite 200 Atlanta, GA 30339 UNITED STATES jeff@sladlaw.com Phone:404-252-0900
----------------------	--

Registration Subject to Cancellation

Registration No	3414489	Registration date	04/22/2008
Registrant	Platinum Bank 802 West Lumsden Road, Suite B Brandon, FL 33511 UNITED STATES		

Goods/Services Subject to Cancellation

Class 036. First Use: 1997/08/01 First Use In Commerce: 1997/08/01 All goods and services in the class are cancelled, namely: Banking services

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77661274	Application Date	02/02/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PT PLATINUM COMMUNITY BANK		

Design Mark	 The logo features the letters 'Pt' in a large, bold, sans-serif font, enclosed within two vertical lines. To the right of this graphic, the word 'Platinum' is written in a large, bold, sans-serif font, and the words 'COMMUNITY BANK' are written in a smaller, bold, sans-serif font below it.
Description of Mark	The mark consists of a stylized depiction of the letters Pt in between two vertical lines. A stylized depiction of the word Platinum appears to the right of the vertical lines. A stylized depiction of the words COMMUNITY BANK appears below the word Platinum.
Goods/Services	Class 036. First use: First Use: 2008/10/31 First Use In Commerce: 2008/10/31 Banking and lending services

Attachments	77661274#TMSN.jpeg (1 page)(bytes) PLATINUM Cancellation.pdf (9 pages)(246592 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jeffrey B. Sladkus/
Name	Jeffrey B. Sladkus
Date	06/10/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

PLATINUM COMMUNITY BANK, FSB)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
PLATINUM BANK)	
)	
Registrant.)	

PETITION TO CANCEL

Petitioner, Platinum Community Bank, FSB, a federally chartered savings bank ("Petitioner"), believes that it is being damaged by the continued registration of Registrant's PLATINUM BANK BB & design mark, U.S. Registration No. 3,414,489 (the "Registration"), and hereby petitions for cancellation of the Registration. As grounds for cancellation of the Registration, Petitioner respectfully alleges as follows:

1. Petitioner is a federally chartered savings bank with offices located at 2915 W. Kirchoff Rd., Rolling Meadows, Illinois 60008.
2. Platinum Bank, is a Florida corporation with offices located at 802 West Lumsden Road, Suite B, Brandon, Florida, 33511 ("Registrant").
3. The mark subject of this Petition to Cancel is a design word mark, PLATINUM BANK BB, as more specifically set forth below and in the Registration, registered on April 22, 2008 in International Class 36 for: "*Banking services*" (the "PBBB Mark"):



4. Petitioner has established extensive common law rights in the mark PLATINUM as used in connection with banking and lending services in multiple states.

5. Petitioner has filed with the U.S. Patent and Trademark Office (“USPTO”) an application to register its PT PLATINUM COMMUNITY BANK & design mark, which has been assigned U.S. Trademark Application Serial No. 77/661,274 (the “Application”) as more specifically depicted as follows:



6. Petitioner has used the mark PLATINUM since at least as early as 1999. Petitioner has been promoting and providing its banking and lending services for many years, and is currently promoting and providing its banking and lending services under the mark PT PLATINUM COMMUNITY BANK & Design in multiple states.

Ground One for Cancellation
Registration was Obtained Fraudulently

7. Registrant is a Florida corporation providing banking services in certain counties within the State of Florida.

8. On September 28, 2007, Registrant filed an application to register the P BBB Mark alleging use dating back to 1997 and identifying “*banking services*” in International Class 36. The application was assigned U.S. Trademark Application Serial No. 77/291339, and issued to registration on April 22, 2008 as U.S. Trademark Registration No. 3,414,489.

9. Upon information and belief, Registrant has not used the registered P BBB Mark “in commerce” as defined by Section 45 of the Trademark Act 15 U.S.C. §1127 (“Section 45 of the Lanham Act”) because the Registrant only operates within the State of Florida and does not offer its banking services in other states.

10. On information and belief, Registrant has not used the registered P BBB Mark “in commerce” as defined by Section 45 of the Lanham Act because pursuant to federal banking laws, a banking institution must be licensed within the state upon which it operates to provide services to its customers within that specific state and, therefore, since Registrant is not operating any branches outside of the State of Florida, Petitioner alleges, on information and belief, that Registrant is not authorized by the federal banking commission to provide services outside the State of Florida. Therefore, Registrant cannot provide its banking services “in commerce” as defined by Section 45 of the Lanham Act.

11. In support of the foregoing, Registrant specifically states on Registrant’s website “About Us” page that their “Market Area” is principally Hillsborough and Polk counties (Florida) and the surrounding areas. Attached as **Exhibit A** is a copy from Registrant’s “About Us” page from its website.

12. As a result of Registrant’s conduct, P BBB either was aware, or should have been aware, that providing its services only within the State of Florida was not use of its P BBB Mark “in commerce” as defined by Section 45 of the Lanham Act.

13. Upon information and belief, such misrepresentations that the PBBB mark was used “in commerce” were material, were made with knowledge and intent and were false and misleading.

14. Accordingly, upon information and belief, Registrant made a fraudulent statement and oath in its application filed with the USPTO on September 28, 2007.

15. By reason of the foregoing, Petitioner will be damaged by the continued registration of Registrant’s PBBB Mark and, accordingly, the Registration should be cancelled.

Ground Two for Cancellation
Likelihood of Confusion Pursuant to Section 2(d) of the Lanham Act

16. Registrant is a Florida corporation providing banking services in certain counties within the State of Florida.

17. Upon information and belief, Registrant only operates and is only licensed to operate in the State of Florida and does not offer its banking services in other states. Therefore, Registrant can only claim rights to its PBBB Mark in the State of Florida, and more specifically to limited geographic areas in which it operates.

18. Petitioner has used the mark PLATINUM in association with banking services since at least as early as 1999, and was operating in interstate commerce since well prior to the filing of Registrant’s Application Serial No. 77/291,339 - which was filed on September 28, 2007 (the “PBBB Application”).

19. Petitioner is the owner of its pending Application, as well as its extensive common law rights in the mark PLATINUM.

20. Petitioner has been providing its banking and lending services in connection with its PLATINUM mark well-prior to the filing date of the Registrant’s PBBB Application.

21. Since well prior to the filing date of Registrant's PBBB Application, Petitioner has, and is now, engaged in advertising, marketing, and promoting its banking and lending services under the mark PLATINUM in various states.

22. Through such promotion and marketing of Petitioner's banking and lending services, the mark PLATINUM has come to be associated with Petitioner, and distinguishes Petitioner's banking and lending services from the goods and services of others.

23. Moreover, through such promotion and marketing of Petitioner's banking and lending services under the mark PLATINUM, relevant customers, as well as the general public, have come to know and associate Petitioner's banking and lending services with the mark PLATINUM.

24. Petitioner will rely herein on its USPTO Application Serial No. 77/661274, as well as its U.S. common law rights in the mark PLATINUM.

25. The mark sought to be cancelled by Petitioner is confusingly similar to, Petitioner's PLATINUM mark.

26. The services identified in the Registration are commercially related to the Petitioner's banking and lending services marketed and provided by Petitioner under its PLATINUM mark.

27. Continued registration and/or use of Registrant's mark covered by the Registration: (i) is likely to cause confusion, mistake, and will deceive the general public as to the origin, sponsorship, and association of Registrant's wholly local services with Petitioner's services provided in several states under its mark; (ii) will mislead the general purchasing public into believing that Registrant's services are provided by, emanate from, or are in some way, directly or indirectly, associated with Petitioner, all to the damage and detriment of Petitioner.

28. If Registrant's Registration is permitted to continue in force maintaining Registrant's rights as conferred under the Principal Register of the Trademark Act of 1946, Registrant will unlawfully gain an advantage to which it is not entitled under the Trademark Act of 1946, to the detriment and harm of Petitioner.

29. By reason of the foregoing, Petitioner will be damaged by the continued registration of Registrant's Registration and, accordingly, the Registration should be cancelled.

WHEREFORE, Petitioner, believes and alleges that it will be damaged by continued registration of Registration No. 3,414,489 and prays that the present cancellation proceeding be sustained and judgment be entered in favor of Petitioner cancelling Registration No. 3,414,489.

The cancellation fee of \$300.00 is submitted herewith.

DATED this 10th day of June, 2009.

Respectfully submitted,

PLATINUM COMMUNITY BANK, FSB.



By: _____

Jeffrey B. Sladkus, Esq.
Jeffrey B. Sladkus, LLC
1827 Powers Ferry Road
Building 6, Suite 200
Atlanta, Georgia 30339
Tel: (404) 252-0900
Fax: (404) 252-0970

Attorney for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the Petition to Cancel was deposited with United States Postal Service on June 10, 2009 by first class postage prepaid air mail addressed to:

Mary Ann Stiles, Esq.
Stiles, Taylor & Grace
P.O. Box 460
Tampa, FL 33601



Jeffrey B. Sladkus

Dated: June 10, 2009
Atlanta, Georgia

Exhibit A



- Personal Online Banking
 Online Business Banking
 Online Premier Business Banking

Access ID:

Log In

Logging in to our Internet Banking System is for authorized purposes only. Unauthorized access or use is strictly prohibited. Activity on this site is monitored for security purposes.

Home

Online Banking

About Us

Personal Services

Commercial Services

Loan Services

Rates

Locations & Hours

About Us - Our Bank

Our People

Our Bank

Platinum Bank™ commenced banking operations in December 1997. It is our mission to provide high quality financial products with personalized customer service. We conduct business at these locations: our Main Office at 802 West Lumsden Road in Brandon; our Polk County Offices at 5404 South Florida Avenue and 724 South Florida Avenue in Lakeland; our Tampa Office at 408 South MacDill Avenue, Tampa, Plant City Office at 1804 James L Redman Parkway in Plant City and our newest location at 1285 First Street South in Winter Haven.

Our Strategy

The Bank's business strategy is to cater to consumers, professionals, small businesses, developers and commercial real estate investors by offering quality, personalized financial services which have become less available due to consolidation in the banking industry. We also seek to build our deposit base and loan portfolio through service-oriented relationship banking.

Our Market Area

Our primary market area consists principally of Hillsborough and Polk counties and surrounding areas.

LOCAL OWNERS. LOCAL DECISIONS.



[Home](#) | [Online Banking](#) | [About Us](#) | [Personal Services](#) | [Commercial Services](#) | [Loan Services](#) | [ATM Locations](#) | [Rates](#) | [Locations & Hours](#) | [Privacy Policy](#) | [Contact Us](#)